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REMARKS

The examiner is thanked for her consideration of the application. Claims 1, 2, 6, 7, 9-19, and 28, 30-32, and 34-42 are pending and all claims remain rejected. Claim 28 has been amended.

No new matter is added by this amendment. Admission of this amendment is respectfully requested.

37 CFR §112 REJECTIONS

Claim 28 has been amended thereby obviating these objections.

OBJECTION TO THE SPECIFICATION

The specification has been amended to eliminate the examiner's objection to the incorporation of material from WO92/13030 and WO01/29170.

37 CFR §103 REJECTIONS

The Examiner maintained the previous rejection of all claims as obvious over Herrmann et al. (US 6,248,706).

I. The Examiner has failed to cite (1) any reference that discloses the reductase concentrations in independent claims 1 and claim 28; and/or failed to cite (2) any reference that teaches reductase, in specified concentrations as claimed, to provide a particle with the property of enhanced storage stability for a peroxide sensitive agent (Claims 1 and 28); and any reference that teaches specific concentrations of a reductase in a detergent particle without significantly reduced active oxygen in the detergent as in claim 42.

The Examiner admits that "The prior art does not teach the specific concentrations of the reductase catalase in baker units as recited by the instant claims". But the Examiner's continued basis for the obviousness rejection, namely stating the Herrmann et al. provide motivation to modify concentration of the reductase to reach the levels claimed by applicants, is flawed and probably based on hindsight reconstruction because, in the first instance, Herrmann et al. do not teach the use of reductase for anything except desizing textiles. There is no possible reading of Herrmann et al. that provides guidance on a reductase level that stabilizes a peroxide sensitive active

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(Claims 1 and 28), or guidance on how to select a reductase level that will not reduce active oxygen in detergent with bleach (claim 42), or guidance to select the reductase in the first place to stabilize the peroxide sensitive active.

The general teachings in Herrmann et al. on enzyme concentration do not teach or suggest to one skilled in the art the enzyme activity level or concentration, or the specific combination of enzymes in claims 1 and 28. Col. 2, Ins. 19-67, as cited by the Examiner, of Herrmann et al. provide a value by weight of enzyme or total enzyme mixture and a value of the remaining material used to form the core (organic flour), but there is no teaching at all of weight percents for multiple enzymes relative to each other anywhere in the specification and examples. The single enzyme activity levels taught by Herrmann et al. in Experiments 2.4 and 2.5 are not for reductases and are at levels (the lowest is 401,000 MWU/g for amylase) which on their face appear to be much higher than the reductase levels claimed by applicants, although the units are different from the claimed units because the enzymes are different from the claimed enzymes. Col. 7, Ins. 15-20 teach only that "the amount of enzyme is dependent upon the individual specific enzyme activity and the desired activity in the prepared enzyme granulate", and such a teaching does not motivate one skilled in the art to look at the activity level of an enzyme in relationship to the possible presence of any other enzyme or active ingredient. The Examiner further has not explained why she considers the activity level of applicants' reductase to be a "broad range of concentrations", particularly in view of the six and seven digit activity levels in the experiments of Herrmann et al. Page 5, l18 of applicants' specification states that the reductase is "at relatively low concentrations".

A *prima facie* case of obviousness requires the Examiner to cite to a reference or a combination of references which (a) suggests or motivates one of skill in the art to modify the teachings of the reference(s) to yield the claimed invention, (b) discloses the elements of the claimed invention, and (c) provides a reasonable expectation of success should the claimed invention be carried out. Failure to establish any one of these requirements precludes a finding of a *prima facie* case of obviousness.

"It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." *Northern Telecom v. Data point corp.*, 908 F.2d 931, 934, 15 USPQ 2d 1321 (Fed. Cir. 1990)

Thus, in order to establish a *prima facie* case of obviousness the USPTO must show some objective teaching in the prior art or that knowledge generally available to

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one skilled in the art would lead that individual to combine the relevant teachings of the references. *In re fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). To invalidate claimed subject matter for obviousness, the combined teachings of the prior art references must suggest, expressly or by implication, the improvements embodied by the invention. *In re GPAC*, 57 F.3d 1573, 35 USPQ2d 1116 (Fed. Cir. 1995) (citing *In re Sernaker*, 702 F. 2d 989, 217 USPQ 1 (Fed. Cir. 1983). The teachings of references can be combined only if there is some suggestion or incentive to do so.

Herrmann et al do not specifically suggest the combination of enzymes claimed or the claimed concentration of the reductase, do not suggest reductase to stabilize the active agent, and do not teach a detergent with bleach and the active agent/reductase combination where the active oxygen is not significantly reduced. As noted in previous amendments, looking to a teaching in Herrmann et al. for enzyme stabilization would lead only to Col. 7, lines 61-67, stating that customary enzyme stabilizers can be used, and lists "sodium benzoate, calcium salts, nonreducing mono-, di-, and trisaccharides, parabens, potassium and sodium sorbate, and common salts", not other enzymes.

Reference RD 3534A to Novo Nordisk does not correct the deficiencies noted above with respect to the cited references. Specifically, RD 3534A does not teach the reductase concentrations in independent claims 1 and claim-28; and/or does not teach a reductase, and in specified concentrations, to provide a particle with the property of enhanced storage stability for the active agent (Claims 1 and 28); and/or does not teach specific concentrations of a reductase in a detergent without significantly reduced active oxygen as in claim 42. RD 3534A does not teach the specific combination of a peroxide sensitive enzyme and a reductase, does not teach the concentration of the reductase, does not teach that the reductase stabilizes the peroxide sensitive enzyme, and does not teach a detergent with bleach and with reductase where the active oxygen is not significantly reduced.

Based on the above criteria, Applicants maintain that the cited prior art cannot lead one skilled in the art to the invention as claimed and does not constitute a *prima facie* case of obviousness.

II. The Examiner incorrectly insists that Herrmann et al. teach feeding the enzyme granulate to a high-speed mixer, which indicates failure of the Examiner to fully appreciate and understand the teachings of the Herrmann et al reference.

Applicants wish to point out that the Examiner is not correct in citing that Col. 6, Ins. 8-45 teach that the enzyme granulate can be fed to a high-speed mixer and after

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drying the enzyme granulate can additionally be coated. The enzyme granulate is a particle. The reference actually teaches that "the powdered, optionally premixed constituents for the enzyme granulate can be fed to the high-speed mixer...". These constituents are the enzyme and the flour and a liquid and the high-speed mixer homogeneously mixes these constituents together to form a particle which is the granulate.

III. The Examiner was mistaken, and should have allowed at least some of applicants' claims (specifically claim 19 and its dependent claims), when she stated that (i.e. "the combination of an oxidoreductase and an active agent in the presence of a bleaching compound are not recited in the rejected claim(s)"). Applicants pointed this out to the Examiner in its last amendment, but the Examiner still has not addressed these claims.

Applicants respectfully request that the Examiner reconsider her rejection of claims 19, 30-35 and 42. Specifically, claim 19 is to a detergent with peroxygen bleach and the particle of claim 1 and claims 30-35, and 42 depend from claim 19. Applicant contends that these claims should not have been rejected in the last office action because they do claim the combination of an oxidoreductase and an active agent in the presence of a detergent having a bleaching compound. Claim 42 further adds that the active oxygen of the detergent is not significantly reduced by the enzyme combination.

IV. Applicants must unmistakably conclude that the Examiner is engaging in an impermissible hindsight reconstruction of Applicants' invention from Herrmann et al. and from RD3534 and that the Examiner is not considering Applicants' claims as a whole.

Applicants' combination is not fairly suggested in the prior art, the rejections are based on impermissibly picking and choosing ingredients without considering the inventions as a whole, and the rejection looks suspiciously like hindsight reconstruction reached through the teachings of Applicants' disclosure. Indeed, an obviousness rejection is inappropriate, where the prior art [gives] either no indication of which parameters [are] critical or no direction as to which of many possible choices is likely to be successful" (quoting *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 [Fed. Cir. 1988], *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 10 USPQ2d 1843, 1845 [Fed. Cir. 1989]).

Applicants contend that an obviousness rejection must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention

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from the prior art. In making this evaluation, all of the facts must be considered, and the Examiner must supply the factual basis for the rejection. The Examiner may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See, *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). Furthermore, as stated by the Federal Circuit, (*W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 [Fed. Cir. 1983]):

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Finally, a fundamental requisite of establishing a *prima facie* case of obviousness is that there is a reasonable expectation of success in practicing the recited method steps or producing the claimed composition, without the use of the pending Application. Indeed,

"[t]he reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure."¹

Furthermore, "routine experimentation" or something that is "routine in the art" does not negate patentability. (See, *In re Fay*, 347 F.2d 597, 146 USPQ 47, 51 (CCPA 1965); 35 U.S.C. § 103(a) ["Patentability shall not be negated by the manner in which the invention was made"]). Thus, even if "routine experimentation" would lead one of ordinary skill in the art to produce the presently claimed compositions and methods, such a rejection would be improper. Under the law, an Examiner is **not** "one skilled in the art." (See, *Stratoflex, Inc., v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 879 [Fed. Cir. 1983]). Consequently, the Examiner's own views regarding the obviousness of the presently claimed compositions and methods cannot enter into the determination of obviousness.

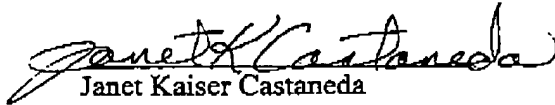
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Applicants respectfully request reexamination and reconsideration of the claims and admission of the amendment after final to place the claims in condition for an appeal if necessary. The Examiner is invited to telephone the undersigned if it is believed that such a call will hasten allowance.

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Respectfully submitted,

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